



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/538,767	03/30/2000	Yvonne Ng	1697 (USW 0562 PUS)	8838

22193 7590 11/23/2001

QWEST COMMUNICATIONS INTERNATIONAL INC
LAW DEPT INTELLECTUAL PROPERTY GROUP
1801 CALIFORNIA STREET, SUITE 3800
DENVER, CO 80202

EXAMINER

LEE, SEUNG H

ART UNIT PAPER NUMBER

2876

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/538,767

Applicant(s)

NG, YVONNE

Examiner

Seung H Lee

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Receipt is acknowledged of the Amendment filed on 21 September 2001, which has been entered in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 3 - 6, 11, 14 – 17, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hohle (US 6,199,762).

Re claims 1, 11, and 22 - 23: a system for managing a plurality of local lists of a single user, the plurality of local lists being at a plurality of remote appliances where each appliance holds a corresponding local list and includes a card reader (102), the system comprising,

A compact user-carried smart card (120) including a microprocessor and a memory storing a master list (see col. 1, line 15 – 38), the master list being configured for synchronizing with each host, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliance and synchronize the master list with the various list of the appliance (see Fig. 8; col. 14, line 13 – 23),

Re claims 3 – 6, 14 –17: the list include a plurality of entries and at least one of the entries is an address, a name, a telephone number, an email address (see Fig. 11).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 12, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle.

The teachings of Hohle have been discussed above.

Although, Hohle teaches the synchronizing the data between the smart card and the remote appliance, Hohle fails to teach or fairly suggest that a remote appliance is configured to display a list and includes a card reader.

It would have been an obvious to one of ordinary artisan in the art to adapt the notoriously old and well-known display and card reader to display the information/list on the display device using the card reader, due to the fact that the remote appliance must include the display and the card reader in order to provide better means visual recognition of the smart card by the smart card reader and choosing and running the appropriate stored program to synchronize the data, and therefore an obvious expedient.

6. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle in view of an article entitled "PubliCARD unveils SmartPassky™, the first smart

card-enabled password management system for heavy Internet users” by PubliCard [hereinafter the “article”, cited by applicant].

The teachings of Hohle have been discussed above.

In addition to the teachings of Hohle, he also teaches the non-web-enabled appliance (see col. 1, line 20 - 25). However, Hohle fails to teach or fairly suggest the smart card memory includes an electronic bookmark and web-enabled enabled appliances.

The “article” discloses the smart card memory includes an electronic bookmark (URLs) and web-enabled appliances (see page 1, line 11 – 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the smart card memory to store a bookmark and web-enabled appliance as taught by the “article” to the teachings of Hohle in order to provide heavy internet users with easy access to the Internet sites with personal preferences such as bookmarked URLs. Also, such modification (i.e., a web-enabled appliance) would provide the operator with easier connection means to the Internet through the smart card hosting device (i.e., Personal computer) programmed with a dynamic programming language (i.e., JAVA, C, C++, etc). Furthermore, such modification would provide the simpler process of connecting to the Internet means and accessing the Internet sites by providing password to the prompted application on the display of the web-enabled appliance, and therefore an obvious expedient.

7. Claims 8, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle in view of Teicher (US 5,744,787).

The teachings of Hohle have been discussed above.

Although, Hohle teaches the smart card system, he fails to teach or fairly suggest the memory include an electronic wallet.

Teicher discloses the electronic wallet (9) (see Fig. 4; col. 1, line 21 – 57).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the conventional electronic wallet as taught by Teicher to the teachings of Hohle in order to provide a easier and quicker transaction of purchase at the point of sale (POS) terminal, gas station, or the like. Such modification would provide a constant acknowledgement of the value of electronic wallet every time the electronic funds are consumed by the customers (i.e., unlike the conventional/typical credit card which the customers have to wait until the monthly billing statement or to call the customer service center to verify the past transaction. Furthermore, such modification would provide the easier replenishing the value of the electronic wallet by authorizing cash/money transfer from the bank account (i.e., the checking account, the credit card) to the smart card using ATM, telephone, Internet transaction, or the like, then the value of electronic wallet on the smart card will be replenished during the next authorization process, and therefore an obvious expedient.

8. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle in view of Taylor (US 5,578,808).

The teachings of Hohle have been discussed above.

Although, Hohle teaches the smart card system, Hohle fails to teach or fairly suggest that at least one of the pluralities of entries is a password

Taylor teaches the password (PIN) (see Fig. 1; col. 3, line 21 – 40).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the notoriously old and well known password as taught by Taylor to the teachings of Hohle in order to provide a secure process of the accessing each application on the smart card by assigning each application with its own unique password. Also, such modification (assigning the password with its own application) would prevent accidental processing of a particular application, since each application password can be different from other application's password and only the application with correct assigned password can authorize the processing, and therefore an obvious expedient

9. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohle in view of Chen et al. (US 5,694,471).

The teachings of Hohle have been discussed above.

Although, Hohle teaches a smart card system, Hohle fails to teach or fairly suggest that the smart card having encrypted password to control access the master list.

Chen teaches the using encrypted password to access the application onto the smart card to access the application onto the smart card (420 – 450)(see Fig. 5; col. 2, line 9 – 39; col. 10, line 14 – 31).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the well known encrypted password as taught by Chen to the teachings of the Hohle in order to provide an improve authentication

process to access the master list within the smart card. Also, such modification would provide a secure synchronizing process by having the conventionally known encrypted password assigned to the smart card to be verified by the remote appliance to synchronize between the local list in the remote appliance and the master list on the smart card, therefore and an obvious expedient.

Response to Arguments

10. Applicant's arguments filed 6 June 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that a system for managing a plurality if a single user, the plurality of local lists being at a plurality of remote appliance according to claim 1 includes a remote appliances holding corresponding local lists with each remote appliance including a card reader and a microprocessor program to synchronize the master list with a local list of a remote appliance when a smart card is engaged with the remote appliance card reader (see page 4 of the response filed on 6 June 2001), claim 1 reads, lines 5 - 11, " a compact user-carried smart card including a microprocessor and a memory storing a master list, the master list being configured for synchronizing with each host, the microprocessor being programmed to synchronize the master list with a local list on a remote appliance card reader to allow the user to carry the smart card with the master list stored in the smart card memory to various remote appliance and synchronize the master list with the various list of the appliance. Hohle teaches a compact user-carried smart card (120) including a microprocessor and a memory storing a master list (see col. 1, line 15 – 38), the master list being configured

Art Unit: 2876

for synchronizing (808) with each host (see Fig. 8; col. 14, line 13 – 23). Since synchronizing of the data between the master list on the smart card and the local list on remote appliance requires the some type of program which is configured to run/execute by the microprocessor to recognize the presence of the smart card inserted into the card reader and synchronizing data automatically or manually by user/operator (see col. 4, line 47 - col. 5, line 7). Therefore, given its broadest reasonable interpretation, Hohle meets the claimed invention.

In response to applicant's argument that the adapting of the display and card reader is non-obvious to one of ordinary skill in the art (see page 3, line 22+), the Examiner respectfully disagrees with the applicants wherein the card reader and display are essential equipments to read-in the information stored on the smart card and to display instruction/status of the operating of the card reader. Moreover, Hole teaches the smart card reader and the PC system as an access points as further evidence in which meet the claimed invention (see col. 4, line 47- col. 5, line 7).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure;

Dancs et al. [US 6,141,752], White et al. [US 5,983,273] disclose the smart card,
Short et al. [US 6,194,992] discloses a mobile web information exchange device.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (703) 308-5894. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.


If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax-phone number for this group is (703) 308-5841 or (703) 308-7722.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[michael.lee@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Art Unit: 2876

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


Seung H. Lee
Art Unit 2876
November 19, 2001


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800